



DAC / 2675 ZWW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Takao INOUE

Serial No.: 10/060,398

Group Art Unit: 2675

Filed: February 1, 2002

Examiner: C. Nguyen

For: LIGHT EMITTING DIODE DRIVING CIRCUIT

Honorable Assistant Commissioner of Patents
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.181

Sir:

Applicant hereby petitions under 37 C.F.R. §1.181 to invoke the supervisory authority of the Commissioner to refund the two-month time extension fee (\$450.00) imposed by the Examiner for executing an After-Final Examiner's Amendment for the above-referenced Application and a review of internal procedures as understood by Examiners when confronting the facts described below. Applicant submits that the exception described in MPEP §706.07(f) (I) and the procedure described in MPEP §706.07(f) (N) clearly applies in the specific facts of this instance.

Statement of the Facts

Applicant's representative received a telephone call from the newly-assigned Examiner on March 23, 2005. The newly-assigned Examiner stated that, upon reviewing the record from the previous Examiner, he was ready to allow the Application if claims 8 and 9 were incorporated into claim 6. Following coordination with the Applicant, Applicant's representative on March 24, 2005, authorized the Examiner to make such changes by Examiner's Amendment.

The Examiner called back requesting authorization to charge the Applicant's representative's deposit number for a time extension fee. Applicant's representative stated that he

S/N: 10/060,398
Attorney Docket: PU01-01115
FUJI.014

considered that the charge for the time extension fee was not appropriate in this instance under the exception described in MPEP §706.07(f) (I): *"However, an examiner's amendment correcting only formal matters which are identified for the first time after a reply is made to a final Office action would not require any extension fee, since the reply to the final Office action put the application in condition for allowance except for the correction of formal matters, the correction of which had not yet been required by the examiner."*

However, upon refusal of the Examiner and his Supervisory Examiner to honor this exception, in order to expedite prosecution, Applicant's representative authorized that Attorney Deposit Account No. 50-0481 be charged for the time extension fee.

Applicant's Position

In addition to the exception from MPEP §706.07(f) (I) recited above, Applicant submits that the specific facts iterated above falls squarely in the procedure that could or should have been followed by the Examiner if a time extension fee is to imposed for executing an Examiner's Amendment, as described in MPEP §706.07(f) (N): *"Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an Ex parte Quayle action if the application is otherwise in condition for allowance. No extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters - the correction of which had not yet been required by the examiner."*

Applicant submits that, in the present instance, the Examiner's requirement that dependent claims be incorporated into the independent claim was a mere formal matter that was not previously of record by either the newly-appointed Examiner or the previous Examiner and could easily have been executed by Applicant in response to an Ex parte Quayle action with no time extension fee.

That is, if an Examiner does not wish to execute an Examiner's Amendment, it is

S/N: 10/060,398
Attorney Docket: PU01-01115
FUJI.014

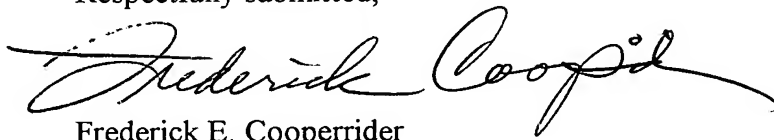
submitted that the appropriate procedure, clearly identified in MPEP §706.07(f) (N) is that the Examiner instead prepares an *Ex parte Quayle* action so that Applicant himself can then make the formal corrections.

Clearly, in the present fact scenario, the Examiner preferred to execute the Examiner's Amendment rather than prepare the *Ex parte Quayle* action. Applicant submits that the practice of imposing a time extension fee under the facts described above constitutes an abusive practice by the USPTO.

Therefore, this Petition requests review by the Commissioner of these specific facts, review of the internal understanding by Examiners of procedures to be used when confronted by this fact pattern, and, if appropriate, the refund of the \$450.00 time extension fee imposed in this instance.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481 in regard to this Petition.

Respectfully submitted,


Frederick E. Cooperrider
Reg. No. 36, 769

Date: 4/8/03

McGinn & Gibb, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254